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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,185	08/23/2001	Charles W. Propst Jr	TPP 30482 A	9479

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EXAMINER	
BRUENJES, CHRISTOPHER P	
ART UNIT	PAPER NUMBER
1772	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/914,185	PROPST JR, CHARLES W.	
	Examiner	Art Unit	
	Christopher P. Bruenjes	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 May 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5 and 7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *5 and 7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Jugle (USPN 4,971,882).

Jugle anticipate a toner of a conductive polymeric composition. Jugle teaches that the toner is applied to a substrate (col.18, l.59-68) and that substrates that toner is applied to include paper (col.3, l.21-30). The coated layer forms a film on the paper layer. Regardless of whether the toner forms a discontinuous or continuous film it still meets the limitation film of a conductive polymeric composition. The limitation that the "polymeric composition is a dried layer

formed from an intermediate composition comprising an aqueous composition" is given little patentable weight because it is a method limitation in an article claim. A layer that is not in an aqueous solution has the same properties as a layer formed from an aqueous solution that has been dried, because when dry the layer no longer possesses the water from the aqueous solution. Jugle anticipate a polymeric composition comprising methyl methacrylate (col.7, l.48 - col.8, l.10), a quaternary ammonium compound in an amount of 0.1 to 20wt% and preferably 0.1 to 5wt% of the polymeric composition (col.9, l.27-40), and a polyethylene wax (col.6, l.44-48). Products of identical chemical composition cannot have mutually exclusive properties. Therefore, if the prior art teaches the identical chemical structure, the properties applicant claims are necessarily present. MPEP 2112.01. Because the film is formed of the same composition as the claimed film it inherently imparts a surface resistivity so as to have a static dissipative property of less than 10^{12} ohms/sq and a conductive property of less than 10^{5} ohms/sq to the paper layer. Furthermore, less than 10^{12} ohms/sq and less than 10^{5} ohms/sq would include zero, so the claiming is not requiring any static dissipative property or conductive property. The limitation that the polymeric composition is applied in an aqueous form and dried is given little patentable

weight because articles are defined by structure and not how they were made. Method limitations are only given weight insofar as the structure they provide. MPEP 2113. A composition applied in an aqueous form and dried only provides the structural limitation that the film is a dry layer, which the film of Jugle would be after the toner, is applied to the paper.

3. Claims 5 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Tanikawa et al (USPN 6,653,036).

Tanikawa et al anticipate a magnetic toner applied directly on and in contact with a paper layer (col.20, l.10-15). When applied to the paper the toner forms a film on the paper layer. The magnetic toner is formed of a polymeric composition comprising a binder resin formed of methyl methacrylate polymer (col.10, l.28-63) and a charging controlling agent (col.16, l.28-29). The charging controlling agent includes quaternary ammonium salts (col.16, l.30-35 and 45-47) in an amount within the claimed 1 to 10wt% based on the weight of the polymeric composition (col.19, l.10-16). The magnetic toner further comprises a polyethylene wax (col.14, l.37-39) and zinc oxide particles (col.16, l.10-24). Products of identical chemical composition cannot have mutually exclusive properties.

Therefore, if the prior art teaches the identical chemical structure, the properties applicant claims are necessarily present. MPEP 2112.01. Because the film is formed of the same composition as the claimed film it inherently imparts a surface resistivity so as to have a static dissipative property of less than 10^{12} ohms/sq and a conductive property of less than 10^{5} ohms/sq to the paper layer. Furthermore, less than 10^{12} ohms/sq and less than 10^{5} ohms/sq would include zero, so the claiming is not requiring any static dissipative property or conductive property. The limitation that the polymeric composition is applied in an aqueous form and dried is given little patentable weight because articles are defined by structure and not how they were made. Method limitations are only given weight insofar as the structure they provide. MPEP 2113. A composition applied in an aqueous form and dried only provides the structural limitation that the film is a dry layer, which the film of Tanikawa et al would be after the toner, is applied to the paper.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomita et al (USPN 5,783,517).

Tomita et al teach a paper layer coated in direct contact with a dye receiving layer or film (col.1, l.6-12). The film is a conductive polymeric composition comprising a base polymer comprising methyl methacrylate (col.3, l.38-48 and col.3, l.62 - col.4, l.10). The conductive polymeric composition further comprises a white pigment such as zinc oxide (col.4, l.50-63), a parting agent such as polyethylene wax (col.5, l.1-5), and an antistatic agent such as a quaternary ammonium compound (col.5, l.32-38). The limitation that the polymeric composition is

applied in an aqueous form and dried is given little patentable weight because articles are defined by structure and not how they were made. Method limitations are only given weight insofar as the structure they provide. MPEP 2113. A composition applied in an aqueous form and dried only provides the structural limitation that the film is a dry layer, which the film of Tomita et al would be after the toner, is applied to the paper. Whether the film was an aqueous solution during the formation of the dried film is given little patentable weight, because articles are defined by structure and not the method of making the article. There is no substantial structural difference between a dried aqueous layer and a layer that was not previously in aqueous form.

Tomita et al fail to explicitly teach that the quaternary ammonium compound is present in the polymeric composition in an amount of 1 to 10wt% based on the weight of the polymeric composition. However, Tomita et al teach that the sum of the added additives should be within the range of 0.5 to 30wt% (col.5, l.45-51). Therefore, it would have been obvious to one having ordinary skill in the art that the amount of antistatic agent in the composition would be selected depending on the intended end result of the coated paper layer from within the preferred range for all of the additives combined of 0.5 to

30wt%, as taught by Tomita et al, absent the showing of unexpected results. MPEP 2144.05. Products of identical chemical composition cannot have mutually exclusive properties. Therefore, if the prior art teaches the identical chemical structure, the properties applicant claims are necessarily present. MPEP 2112.01. Because the film is formed of the same composition as the claimed film it inherently imparts a surface resistivity so as to have a static dissipative property of less than 10^{12} ohms/sq and a conductive property of less than 10^{5} ohms/sq to the paper layer. Furthermore, less than 10^{12} ohms/sq and less than 10^{5} ohms/sq would include zero, so the claiming is not requiring any static dissipative property or conductive property.

Response to Arguments

7. Applicant's arguments filed May 23, 2007 have been fully considered but they are not persuasive.

In response to Applicant's argument that the surface resistivity, static dissipative property and conductive properties claimed are not inherent in the paper coated with the polymeric composition, once a reference teaching product appearing to be substantially identical is made the basis of a rejection, and the examiner presents evidence or reasoning

tending to show inherency, the burden shifts to the applicant to show an unobvious difference. See MPEP 2112 V. When the structure recited in the reference is substantially identical to that of the claims, claimed properties or functions are presumed to be inherent. See MPEP 2112.01. The examiner has presented reasoning tending to show inherency from the fact that the composition taught in the references and applicant's invention are substantially identical and the composition of the references and applicant's invention are applied to a paper layer. Therefore, the structure taught in the references appears to be the same as the structure taught by the applicant to impart the properties claimed. Thus, the burden is shifted to the applicant to present evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product and applicant has not provided such evidence at this point.

In response to Applicant's specific argument that Tomita et al does not teach the specific amounts of quaternary ammonium compound, it would have been obvious to one having ordinary skill in the art to use 1-10wt% of the quaternary ammonium compound in the composition since Tomita et al teaches the combination of all of the additives is found in an amount between 0.5 and 30wt%. Therefore, Tomita et al does teach the

amount claimed and because it teaches the amount claimed the properties of surface resistivity, static dissipative property, and conductive property would be inherent to the coated paper of Tomita et al for the same reasons as presented above with regard to Jugle and Tanikawa et al.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P. Bruenjes whose telephone number is 571-272-1489.

The examiner can normally be reached on Monday thru Friday from 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher P Bruenjes
Examiner
Art Unit 1772

CPB CPB
July 12, 2007

ALICIA CHEVALIER
PRIMARY EXAMINER